

REMARKS

Reconsideration of the application in view of the foregoing amendment is respectfully requested.

By the present amendment, claim 14 has been added, claim 13 has been canceled, and claims 2, 4 and 9-12 have been amended.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

The Examiner rejected Claims 2-13 under 35 U.S. C. § 103 (a) as being obvious over Neamand, U.S. Patent No. 2,629,588 (Neamand), in view of Watson U.S. Patent No. 1,551,717 (Watson).

It is respectfully submitted that claims 2, 4-12, and 14 are patentable over the cited references. Specifically claim 14 recites that:

- (i) a useful region extending substantially over an entire longitudinal extent of the workpiece side (that adjoins the power tool side);

- (ii) the useful region has a core along an entire longitudinal extent thereof;
- (iii) the useful region has an outer diameter tapering to the workpiece end thereof and has a cross-section formed as a concave polygon by a plurality of axial grooves extending axially over substantially the entire longitudinal extent of the useful region and up to the chipping tip and radially toward the core of the useful region;
- (iv) the core diameter likewise tapers toward the workpiece end of the useful region along a substantially axial extent of the core; and
- (v) cross-sectional surfaces of the cross-section of the useful region are similar in different cross-sectional locations of the useful region.

It is respectfully submitted that the foregoing novel features of the present invention, as defined by claim 14, are not disclosed or suggested in the prior art, including Watson and Neamand, whether taken alone or in combination.

Considering the prior art, Neamand discloses none of the items (i)-(v) of claim 14 listed above. Neamand discloses a chisel having a useful region (12) that constitutes a fraction of the workpiece side (11), without a core and without any grooves.

Watson discloses a drill bit again having a very small useful region (4). Watson further discloses that the workpiece side has a cylindrical core (but not the useful region) and grooves (3) extending along the workpiece side but not up to the cutting tip (8).

Even if Neamand is combined, *arguendo*, with Watson, in the manner set forth in the Office Action, the combination would suggest a chisel having a body, but not the useful region, with a cylindrical core and grooves extending to the useful region. The combination would not have a useful region extending substantially along the entire longitudinal extent of the workpiece side and a diameter tapering to the workpiece end, nor would the combination have a core having a diameter tapering toward the workpiece end of the workpiece end of the useful region, whereby cross-sectional surfaces of the cross-section of the useful region, i.e., of a substantially entire workpiece side, are similar.

However, Watson is not believed to be pertinent to the present invention.

The case law holds that

In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

Watson is not in the field of applicant's endeavor, chisels, nor is Watson pertinent to the problems the present invention solves.

Watson relates to a drill bit which functions completely different from a chisel, and the object of Watson is to perfect the shape of the bit. Cooling grooves in Watson are incidental to the object of Watson.

However, even with Watson being, *arguendo*, a pertinent reference, a *prima facie* case of obviousness has not been made.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that neither the first element nor the third element of *prima facie* obviousness has not established.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992 (footnote omitted) (emphasis in original)). See also *In re Sernaker*, 217 U.S.P.Q. 1,6 (Fed. Cir. 1983); *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 U.S.P.Q.2d 1468, 1475 (Fed. Cir. 1988); IU, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989); *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in Neamand and/or Watson for their combination. Neamand does not require cooling grooves, and Watson is not concerned with self-sharpening.

A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP § 2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q.2d 130 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or inference in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” *Id.* At 1301 (emphasis in original). No such evidence is presented in the Office Action. It is noted that the case law rejects the “common knowledge” of one skilled in the art as a substitute for specific evidence that the prior art suggests the invalidating combination or references. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

The Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record is any evidence, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrive at the claimed invention. In re Jones 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

The In re Fritch confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that that teachings of the prior should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obviously.” *In re Spinnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

It is respectfully submitted that the alleged obviousness of the present invention over the combination of Neamand and Watson can be gleaned only from a hindsight reconstruction.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in Uniroyal v. Redkin-Willey, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

Nothing in the prior art suggests the desirability of the combination set forth in the Office Action. The same Court further stated:

. . . it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention.”

In view of the above, it is respectfully submitted that the present invention as defined by claim 14 patentably defines over the prior art, including Neamand and Watson and is, therefore, allowable.

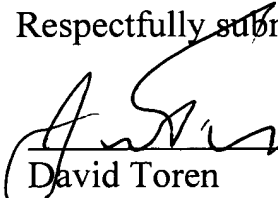
Claims 2 and 4-12 depend on claim 14 and are likewise submitted to be allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

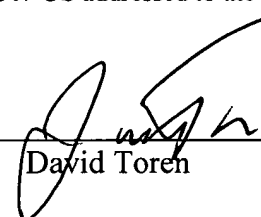
Respectfully submitted,



David Toren
Reg. No. 19,468

Dated: August 18, 2005
Abelman, Frayne & Schwab
666 Third Avenue, 10th Floor
New York, NY 10017-5621
212-885-9383

This correspondence is being deposited with the United States Postal Service on August 18, 2005 in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number **ER 843 204 847 US** addressed to the Honorable Commissioner for Patents, Alexandria, VA 22313-1450.



David Toren